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EXAMINER

INGBERG, TODD D

ART UNIT PAPER NUMBER

2193

DATE MAILED: 11/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/770,705

Applicant(s)

GOUGE ET AL.

Examiner

Todd Ingberg

Art Unit

2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

Claims 1 – 24 have been examined.

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a signal directly or indirectly by claiming a medium and the Specification recites evidence where the computer readable medium is define as a “*wave*” (such as a carrier wave) . In that event, the claims are directed to a form of energy, which at present the office feels does not fall into a category of invention. The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101.

[http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf)

Claim 23 is rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

A communications signal transmitting between two computers a data packet is not tangible. Please, review the current policy on 35 U.S.C. 101 by reviewing the information at the URL above.

Claim 23

A data packet transmitted as a communication signal between at least two computer processes, comprising: a configurable module having: one or more configurable data elements, wherein one or more default values for the one or more configurable data elements are available; one or more non-configurable data elements describing the one or more configurable data elements; and one or more transformation instructions that facilitate configuring the one or more configurable data elements, wherein the instructions are employed to facilitate installation of the one or more configurable data elements into a target data set residing in at least one of the at least two computer processes.

Art Unit: 2193

**Applicant's Argument for the Rejection of Claim 23 Under 35 U.S.C. & 101**

Claim 23 stands rejected under 35 U.S.C. § 101 as because it is alleged that the claimed invention is directed to non-statutory subject matter. Withdrawal of this rejection is requested for at least the following reasons. Claim 23 produces a useful, concrete and tangible result, and the subject claim pertains to transmission of software code between two or more computer processes.

Because the claimed process applies the Boolean principle [abstract idea] to produce a useful, concrete, tangible result ... on its face the claimed process comfortably falls within the scope of §101. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed. Cir. 1999) (Emphasis added); See *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998). The inquiry into patentability requires an examination of the contested claims to see if the claimed subject matter, as a whole, is a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea," or if the mathematical concept has been reduced to some practical application rendering it "useful." *AT&T* at 1357 citing *In re Alappat*, 33 F.3d 1526, 31 1544, 31 U.S.P.Q.21 (BNA) 1545, 1557 (Fed. Cir. 1994) (emphasis added).

The Examiner contends: "[a] communications signal transmitting between two computers a data packet is not tangible." Applicants' representative disagrees and submits the Examiner is misconstruing the requirements necessary to fulfill the conditions for patentability under 35 U.S.C. § 101. According to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), the standard set forth by the Federal Circuit for determining whether claims are directed towards statutory subject matter is whether the claims as a whole can be applied in a practical application to produce a useful, concrete and tangible result. It is the result of the claims as applied in a practical application that is germane to the determination of whether the claims are directed towards statutory subject matter, not whether the underlying means by which the result is effectuated that should be tangible, as the Examiner intimates. It is believed therefore that the subject claim clearly satisfies this legal standard. In particular, independent claim 23 recites: a data packet transmitted as a communication signal between at least two computer processes, comprising: a configurable module having: one or more configurable data elements, wherein one or more default values for the one or more configurable data elements are available; one or more non-configurable data elements describing the one or more configurable data elements; and one or more transformation instructions that facilitate configuring the one or more configurable data elements, wherein the instructions are employed to facilitate installation of the one or more configurable data elements into a target data set residing in at least one of the at least two computer processes. Thus, claim 23 elicits a series of independent acts that culminates in a useful, concrete and tangible result - the installation of the one or more configurable data elements into a target data set residing in at least one of the at least two computer processes.

Additionally, the Court of Appeals for the Federal Circuit stated in *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325 (Fed. Cir. 2005):

Art Unit: 2193

Title 35, section 101, explains that an invention includes "any new and useful process, machine, manufacture or composition of matter." ... Without question, software code alone qualifies as an invention eligible for patenting under these categories, at least as processes. *Id.* at 1338 (emphasis added).

The subject claim clearly pertains to software code comprising a configuration module, one or more configurable data elements, one or more non-configurable data elements, and one or more transformation instructions encapsulated in a data packet transmitted from one computer process to another computer process, so that the transformation instructions contained therein can be employed to facilitate installation of one or more configurable data elements into a target data set residing in at least one of the at least two computer processes. The fact that (i) the data packet that encases the software code during its transmission between two processes, or (ii) the data packet is transmitted as a communication signal between two processes is irrelevant to the fact that it is software code that is contained therein and is being transmitted through utilization of a communication signal. It is submitted that all that is relevant is the fact that software code is being transmitted within the data packet, and that the software code so transmitted produces a useful, concrete and tangible result.

Moreover, the Examiner alleges that the claim is directed to a signal directly or indirectly by claiming a medium and the Specification recites evidence where the computer readable medium is defined as a "wave" (such as a carrier wave), and as such are directed towards a form of energy, which at present the office feels does not fall into a category of invention. The Examiner in order to substantiate this position requests applicants' representative to review the office's current policy at the proffered URL (United States Patent and Trademark Office (USPTO) policy on 35 U.S.C. § 101). (See Office Action dated June 20, 2006, page 2). Applicants' representative having perused the information supplied at the aforementioned URL notes that the policy states that the "Guidelines do not constitute substantive rulemaking and hence do not have the force and effect of law." (Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, page 2 (emphasis added)). It is thus applicants' contention that while the Patent and Trademark Office is entitled to adopt, promulgate, and implement any policy that it so chooses in satisfying its mandate and to provide guidance on the statute and the Federal Court's interpretation thereof, the policy so adopted must be in accord with the Court's statutory interpretation. Additionally, it is applicants' further contention that current Patent and Trademark Office policy with respect to carrier waves is clearly at variance with the interpretation of the Federal Courts in this matter.

To date, the Federal Courts, in particular the Supreme Court, in interpreting the ambit of 35 U.S.C. §101 have observed that Congress intended 35 U.S.C. §101 to include "anything under the sun that is made by man." *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980) quoting S.Rep. No. 1979, 82nd Cong., 2nd Sess., 5 (1952). However, despite the broad interpretive scope set forth, the Supreme Court, admittedly, has held that certain categories of subject matter are not entitled to patent protection. In *Diamond v. Diehr*, 450 U.S. 175 (1981) the Supreme Court explained that there are three recognized categories of subject matter for which one may not obtain patent protection, namely "laws of

Art Unit: 2193

nature, natural phenomena, and abstract ideas." *Id.* at 185. Subsequent decisions from Federal Circuit have not further limited or expanded these exclusionary categories.

As has been stated *supra*, according to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), the legal standard set forth by the Federal circuit for determining whether claims are directed towards statutory subject matter is whether the claims can be applied in a practical application to produce a useful, concrete and tangible result. In *AT&T*, the patent at issue described a message record for long-distance telephone calls that included a primary interexchange carrier ("PIC") indicator, which allowed for differential billing treatment for subscribers. (See *AT&T*, 172 F.3d at 1353). *AT&T*'s claimed process applied Boolean algebra "to determine the value of the PIC indicator, and [applied] that value through switching and recording mechanisms to create a signal useful for billing purposes." (See *AT&T*, 172 F.3d at 1358). Relying on its holdings in *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998), cert. denied, 525 US 1093 (1999) and *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 958 F.2d 1053 (Fed. Cir. 1992), the Court held that the *AT&T* process was patentable subject matter:

In *State Street*, we held that the processing system there was patentable subject matter because the system takes data representing discrete dollar amounts through a series of mathematical calculations to determine a final share price - a useful, concrete, and tangible result. See 149 F.3d at 1373, 47 USPQ2d at 1601. In this case, *Excel* argues, correctly, that the PIC indicator value is derived using a simple mathematical principle (p and q). But that is not determinative because *AT&T* does not claim the Boolean principle as such or attempt to forestall its use in any other application. It is clear from the written description of the '184 patent that *AT&T* is only claiming a process that uses the Boolean principle in order to determine the value of the PIC indicator. The PIC indicator represents information about the call recipient's PIC, a useful, non-abstract result that facilitates differential billing of long-distance calls made by an IXC's subscriber. Because the claimed process applies the Boolean principle to produce a useful, concrete, tangible result without pre-empting other uses of the mathematical principle, on its face the claimed process comfortably falls within the scope of Section 101. See *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1060, 22 USPQ2d 1033, 1039 (Fed. Cir. 1992) ("That the product is numerical is not a criterion of whether the claim is directed to statutory subject matter."). See *AT&T*, 172 F.3d at 1358 (emphasis added).

In *Arrhythmia*, electrocardiograph signals were input into a computer and filtered and analyzed to determine the average magnitude of the signals. The resulting output signal was then compared to a predetermined level to determine whether the patient was at high risk for a particular arrhythmia. The Court found the claims patentable subject matter stating:

The resultant output is not an abstract number, but is a signal related to the patient's heart activity. These claimed steps of "converting", "applying", "determining", and "comparing" are physical process steps that transform one physical, electrical signal into another. The view that "there is nothing necessarily

Art Unit: 2193

physical about 'signals' " is incorrect In re Taner, 681 F.2d 787, 790, 214 USPQ 678, 681 (CCPA 1982) (holding statutory claims to a method of seismic exploration including the mathematically described steps of "summing" and "simulating from") . . . . The computer performed operations transform a particular input signal to a different output signal, in accordance with the internal structure of the computer as configured by electronic instructions. "The claimed invention . . . converts one physical thing into another physical thing just as any other electrical circuitry would do". Arrhythmia, 958 F.2d at 1059, 1060 (citations omitted) (emphasis added).

In State Street, the Federal Circuit remarked upon its decision in Arrhythmia and noted that the transformation of electrocardiographic signals was patentable as "a practical application of an abstract idea . . . because it corresponded to a useful, concrete or tangible thing - the condition of a patient's heart." (State Street, 149 F.3d at 1373). The Federal Circuit also remarked in State Street that:

We note that, for the purposes of a Section 101 analysis, it is of little relevance whether [a claim] is directed to a "machine" or a "process," as long as it falls within at least one of the four enumerated categories of patentable subject matter . . . . State Street, 149, F.3d at 1373.

As noted above, the Federal Circuit case law supports the contention that carrier waves/signals fall within at least one of the four enumerated categories of patentable subject matter. The Federal Circuit has made clear that signals are physical things, (see Arrhythmia, 958 F.2d at 1059, 1060), and as such carrier signals/waves are not naturally occurring phenomena, but rather, manufactured signals which accordingly are patentable products of manufacture in and of themselves. Consequently, in view of the Federal Circuit's holdings with regard to carrier waves/signals it is believed that the Patent and Trademark Office policy that the Examiner is attempting to propound is not in accord with the Federal Courts interpretation of the requirements set forth in Title 35 of the United States Code. Thus, it is submitted that a claim drawn to a data packet transmitted as a communication signal falls squarely within the ambit of statutory subject matter under 35 U.S.C. § 101, and thus should be afforded patent protection regardless of a Patent and Trademark Office policy that is demonstrably erroneous and neither reflective of, nor in accord with, the Federal Courts interpretation in this matter. Accordingly, withdrawal of this rejection is requested.

#### **Examiner's Response**

a. In response to Applicant's arguments based on case law, the following is from the Interim Guidelines:

"In the mid-1990's, the USPTO sought to clarify the legal requirements for statutory subject matter with regard to computer-related inventions. See Examination Guidelines for Computer

Related Inventions, 61 Fed. Reg. 7478 (1996). Subsequent to the publication of those guidelines, the Court of Appeals for the Federal Circuit issued opinions in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999). These decisions explained that, to be eligible for patent protection, the claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601

02. Since this time, the USPTO has seen increasing numbers of applications outside the realm of computer-related inventions that raise subject matter eligibility issues. In order to assist examiners in identifying and resolving these issues, the USPTO is issuing these interim examination guidelines to assist USPTO personnel in the examination of patent applications to determine whether the subject matter as claimed is eligible for patent protection.

The principal objective of these guidelines is to assist examiners in determining, on a case-by-case basis, whether a claimed invention falls within a judicial exception to statutory subject matter (i.e., is nothing more than an abstract idea, law of nature, or natural phenomenon), or whether it is a practical application of a judicial exception to statutory subject matter. The guidelines explain that a practical application of a 35 U.S.C. § 101 judicial exception is claimed if the claimed invention physically transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result.

## **I. INTRODUCTION**



Art Unit: 2193

These Examination Guidelines (“Guidelines”) are based on the USPTO’s current understanding of the law and are believed to be fully consistent with binding precedent of the Supreme Court, the Federal Circuit and the Federal Circuit’s predecessor courts. “”.

b. In response to why the Examiner interprets the Applicant claim as being to signal, the following claim analysis was performed on Claim 23.

Claim 23

A data packet transmitted as a communication signal between at least two computer processes, comprising: a configurable module having: one or more configurable data elements, wherein one or more default values for the one or more configurable data elements are available; one or more non-configurable data elements describing the one or more configurable data elements; and one or more transformation instructions that facilitate configuring the one or more configurable data elements, wherein the instructions are employed to facilitate installation of the one or more configurable data elements into a target data set residing in at least one of the at least two computer processes.

The preamble states the claimed subject matter is toward a *data packet transmitted as a signal between at least two computer processes*. Computer processes are the computer programs for communications (Software). The claim is directed to signal. Current, guidelines forbid the claiming of signals.

From page 51 of the Interim Guidelines: “When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. “

From page 55 of the Interim Guidelines: “A claimed signal has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine. “

From page 57 of the Interim Guidelines: “A product is a tangible physical article or object, some form of matter, which a signal is not. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also

intended to require physical matter. A signal, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of § 101.

On the other hand, from a technological standpoint, a signal encoded with functional descriptive material is similar to a computer-readable memory encoded with functional descriptive material, in that they both create a functional interrelationship with a computer. In other words, a computer is able to execute the encoded functions, regardless of whether the format is a disk or a signal.

These interim guidelines propose that such signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of § 101. “

**Examiner's Disposition**

Applicant's arguments have been considered. The claim is directed to a signal which under the Interim Guidelines do not deem a signal to fall within any of the four statutory classes of 35 U.S.C. § 101. The rejection is maintained.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 9 – 24 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. Microsoft (Assignee) Visual Source Safe (VSS) published 1997.

**Mapping from Claim 1 from Prior Office Action**

Art Unit: 2193

computer implemented system that facilitates software installation (VSS, page 112, merging of software in configuration management tool and VSS, installing occurs in deploying content, pages 71, 81, 89 and 95) comprising: a transformation component that receives one or more configurable data elements (VSS, page 110, Working with Branches, two files) , and one or more non-configurable data elements describing the one or more configurable data elements (VSS, pages 89 – 95, the merge uses a difference that is not configurable but the contents are to an extent – part will be used and part will not - also page 114, binary files describe the one or more configurable data elements binary format being compiled or linked in object code format – describing the source which is configurable) ; and a merge component that employs one or more transformation instructions that configures the one or more configurable data elements to facilitate the installation ( in view of the sections above the merge performs a difference of two files then uses the difference to make one – the result of the difference is merge instructions) of the one or more configurable data elements into at least one target data set (VSS, page 112 – 117, Merging Branches).

**Claim 9**

VSS anticipates a data interpretation system executing on at least one computer, comprising: a data interpretation component that: receives one or more configurable data elements from a configurable module (files as per claim 1), wherein the one or more data elements include configuration information related (difference information as per claim 1) to installing the one or more data elements into a software program (VSS, page 112, merging of software in configuration management tool and VSS, installing occurs in deploying content, pages 71, 81, 89 and 95); applies one or more transformation instructions from the configurable module to the configurable data elements to configure the configurable data elements (the results of the difference are a form of instruction as per above), and installs the configurable data elements into a target data set (VSS, page 112 – 117, Merging Branches) based at least in part upon the configuration information (What two files to merge based on the Branch of claim 1).

**Claim 10**

The system of claim 9, further comprising a user interface to enable a user to query the configurable module to determine which of the one or more data elements are configurable (VSS, page 114, Binary files are not able to be merged- see user interface).

**Claim 11**

The system of claim 9 further comprising: a merging component adapted to receive one or more updated configurable data elements from the data interpretation component and adapted to provide the one or more updated configurable data elements to a target data set. (The difference operation and Merge operation of claim 1)

**Claim 12**

The system of claim 9 further comprising: an authoring schema that describes a configurable module. (VSS, pages 112 – 113, Merging Branches – Figure 8-4).

**Claim 13**

Art Unit: 2193

VSS anticipates a method that is executed on one or more computer for installing a configurable data set into a target data set (VSS, page 112, merging of software in configuration management tool and VSS, installing occurs in deploying content, pages 71, 81, 89 and 95)

, comprising:

- obtaining one or more data elements from a configurable module (as per claim 1);
- including metadata that describes the configuration options of the configurable data set (branch as per claim 1);

- obtaining one or more transformation instructions from the configurable module (as per claim 1 - difference); and applying the one or more transformation instructions to a copy of the one or more data elements from the configurable module to configure the one or more data elements for installation into the target data set (VSS, page 112 - 117, Working with Branches and merging branches as per claim 1).

**Claim 14**

The method of claim 13, further comprising: identifying a target data set; and inserting the updated data elements into the target data set (VSS, page 112 – 117, Merging Branches).

**Claim 15**

The method of claim 13 further comprising: presenting one or more configuration options to a user, accepting one or more configuration selections from the user; and selectively configuring the one or more data elements based on the user's configuration selections. As per claim 10 user selecting branches for merge operations.

**Claim 16**

A computer readable medium containing computer executable instructions operable to perform the method of claim 13. (VSS, is a commercial product – software product – that performs the functions of claim 1).

**Claim 17**

VSS anticipates a computer implemented method for creating a configurable data module, comprising:

- creating a configurable data set having one or more configurable data elements;
- creating one or more data structures containing information associated with one or more configurable data elements; and displaying the information to a software program to facilitate installing the configurable data set into the software program. As per claim 1.

**Claim 18**

The method of claim 17 wherein creating a configurable data set includes: identifying one or more attributes of the one or more data elements; and establishing one or more default values for the attributes of the one or more data elements. As per claim 1.

**Claim 19**

The method of claim 17 wherein creating the one or more data structures (As per claim 1) further comprises:

Art Unit: 2193

identifying one or more locations within a data set that are configurable;  
identifying one or more configuration options (VSS, page 113, Figure 8-4);  
creating one or more instructions concerning how to configure the one or more locations; and storing the instructions in the one or more data structures (The results of the difference guides the merge in a for of instruction as per claim 1).

**Claim 20**

The method of claim 19, wherein the one or more data structures are stored in the configurable data module. ( files as per claim 1).

**Claim 21**

A computer readable medium containing computer executable instructions operable to perform the method of claim 17. (VSS, is a commercial product – software product – that performs the functions of claim 1).

**Claim 22**

VSS anticipates a system that is executed on one or more computer for installing a configurable data set into a target data set (VSS, page 112, merging of software in configuration management tool and VSS, installing occurs in deploying content, pages 71, 81, 89 and 95)  
, comprising: a configurable module having configurable data elements representing a configurable data set and non-configurable data elements representing a portion of the configurable data set (VSS, page 114, binary files describe the one or more configurable data elements binary format being compiled or linked in object code format – describing the source which is configurable); a user interface for selecting which configurable data element to modify (VSS, page 113, Figure 8-4); and a data interpretation system for receiving the configurable and non-configurable data elements (VSS, pages 89 – 95, the merge uses a difference that is not configurable but the contents are to an extent – part will be used and part will not - also page 114, binary files describe the one or more configurable data elements binary format being compiled or linked in object code format – describing the source which is configurable) from the configurable module and applying the transformation instructions (VSS, pages 89- 95, result of difference is the instructions for merging) applicable to the user selections associated with the configurable data elements to enable installing the configurable data set into the target data set (VSS, page 112 – 117, Merging Branches).

**Claim 23**

VSS anticipates a data packet adapted to transmitted as a communication signal between at least two computer processes (VSS, pages 23- 25, 27-28, the product supports Client server as indicated by the installation of the product), comprising: a configurable module having:

one or more configurable data elements, wherein one or more default values for the one or more configurable data elements are available; one or more non-configurable data elements (VSS, pages 89 – 95, the merge uses a difference that is not configurable but the contents are to an extent – part will be used and part will not - also page 114, binary files describe the one or more configurable data elements binary format being compiled or linked in object code format – describing the source which is configurable) describing the one or more

Art Unit: 2193

configurable data elements (As per claim 1) ; and one or more transformation instructions that facilitate configuring the one or more configurable data elements (As per claim 1), wherein the instructions are employed to facilitate installation of the one or more configurable data elements into a target data set (VSS, page 112 – 117, Merging Branches) residing in at least one of the at least two computer processes (VSS, pages 23- 25, 27-28, the product supports Client-Server as indicated by the installation of the product).

#### **Claim 24**

VSS anticipates a computer readable medium having stored thereon a data structure, comprising:  
a first data field containing one or more configurable data elements (as per claim 1), wherein one or more default values for the one or more configurable data elements are available;  
a second data held containing one or more non-configurable data elements describing the one or more configurable data elements ( as per claim 1); and  
a third data field containing one or more transformation instructions that facilitate configuring the one or more configurable data elements to load the configurable data elements into a software program (VSS, page 112 – 117, Merging Branches).  
Examiner selected the bold limitation in view of the OR.

#### ***Allowable Subject Matter***

5. Claims 1- 8 are allowed. Applicant's argument for claim 1 is persuasive. The commercial tool Microsoft Visual Source Safe performs the functions on source code not binary files. Claim 1 clearly and concisely claims the format of the files as binary. The persuasive argument from the Applicant's arguments reads as follows:

"The cited document relates to a software source control or version control package that manages multiple revisions/versions of the same unit of information. Version or source control software typically is employed in software development contexts to manage ongoing development of digital documents such as application source code that may be worked on by a team of people. The Examiner contends the cited document discloses, at pages 89-95 and 114, non-configurable data elements that describe the configurable data elements. Applicants' representative respectfully disagrees. Pages 89-95 ***in summary relate to a file differences function that informs the user of the differences that exist between two files, i.e., determines what has changed between one version of the file to the next version of the file.*** (See e.g., page 90, line 3). Moreover page 114, contrary to the Examiner's indication, ***makes not mention whatsoever, of binary files*** that "describe one or more configurable data elements binary format being compiled or linked in object code format - describing the source which is configurable". (See, Office Action dated June 20, 2006, page 3).

### ***Response to Arguments***

6. Applicant's arguments filed September 21, 2006 have been fully considered but they are not persuasive.

#### **Applicant's Arguments for the Rejection of Claims 9-24 Under 35 U.S.C. &102(b)**

"Claims 1-24 stand rejected under 35 U.S.C. §102(b) based upon a public use or sale of the invention, Microsoft (Assignee) Visual Source Safe (VSS) published 1997. This rejection should be withdrawn for at least the following reasons. The cited document does not disclose or suggest all features recited in the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); See *Yerdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

#### **Examiner's Response to Applicant's Use of Case Law**

In the case of *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), Richardson altered the suspension of a motorcycle. The motorcycle was an existing commercial product. Applicant has not disclosed an existing commercial product they have made modification to. Applicant's use of case law is not persuasive.

#### **Applicant's Argument**

Applicants' claimed subject matter relates to systems and methods for configuring software components that can be incorporated into computer programs, and more particularly, to creating, describing and configuring software components (that are data sets) that are to be incorporated into software programs (target data sets) such that the components are self-describing in relation to configuration possibilities for the software component. An advantage of the subject matter as claimed for example, is that consumers of particular software components to be incorporated into particular applications will have available substantially all data necessary to effect installation of the component as compared to having to gather disjoint data, as is presently the situation. Additionally, the claimed subject matter simplifies and permits automating the creation of program installation data sets. To this end, independent claim 1 (and similarly, independent claims 9, 13, 17, and 22-23) recites: one or more non-configurable data elements describing the one or more configurable data elements. The Visual Source Safe document does not disclose or suggest this pertinent aspect of the claimed subject matter."

#### **Examiner's Response**

Applicant contends that Visual Source Safe does not teach the following:  
"creating, describing and configuring software components (that are data sets) that are to be incorporated into software programs (target data sets) such that the components are self-describing in relation to configuration possibilities for the software component. An advantage of the subject matter as claimed for example, is that consumers of particular software components

Art Unit: 2193

*to be incorporated into particular applications will have available substantially all data necessary to effect installation of the component as compared to having to gather disjoint data, as is presently the situation. Additionally, the claimed subject matter simplifies and permits automating the creation of program installation data sets. To this end, independent claim 1 (and similarly, independent claims 9, 13, 17, and 22-23) recites: one or more non-configurable data elements describing the one or more configurable data elements. The Visual Source Safe document does not disclose or suggest this pertinent aspect of the claimed subject matter."*

The Examiner disagrees. When looking at the functionality of Visual Source Safe with the lack of the limitation the binary file format, Visual Source Safe does in fact take two data sets (two different source files) and perform functions such as MERGE to create a target data set (software program).

#### **Applicant's Argument**

"The cited document relates to a software source control or version control package that manages multiple revisions/versions of the same unit of information. Version or source control software typically is employed in software development contexts to manage ongoing development of digital documents such as application source code that may be worked on by a team of people. The Examiner contends the cited document discloses, at pages 89-95 and 114, non-configurable data elements that describe the configurable data elements. Applicants' representative respectfully disagrees. Pages 89-95 in summary relate to a file differences function that informs the user of the differences that exist between two files, i.e., determines what has changed between one version of the file to the next version of the file. (See e.g., page 90, line 3). Moreover page 114, contrary to the Examiner's indication, makes not mention whatsoever, of binary files that "describe one or more configurable data elements binary format being compiled or linked in object code format - describing the source which is configurable". (See, Office Action dated June 20, 2006, page 3).

Rather, page 114 provides that the Visual merge method is visually complex, and the most important element of understanding the Visual merge is mastering its interface. Additionally, page 114 provides that the Visual merge dialog does not provide a menu bar, but rather presents icons and buttons that have to be used to navigate through the dialog, one difference (a point where a change is present in one file, but not the other) and one conflict (a line of text where both files have a different entry, and Visual Source Safe cannot decide which one to use) at a time. It is thus submitted, the cited document does not disclose or suggest one or more non-configurable data elements describing the one or more configurable data elements as recited by the subject claims. Nowhere in the cited document is this salient aspect of the claimed subject matter disclosed or suggested. Accordingly, withdrawal of this rejection with respect to independent claims 1, 9, 13, 17, and 22-23 (and claims that depend there from) is requested."

#### **Examiner's Response**

Applicant's argument is persuasive for claim 1 because the file format in claim 1 is explicitly claimed to be binary. The functions of MERGE, BRANCH, DIFFERENCE etc meet the claimed invention for claims 9 – 24. Applicant's arguments are dependent on a limitation that is not present (binary file format).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., binary file



Art Unit: 2193

format) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


### ***Correspondence Information***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd Ingberg whose telephone number is (571) 272-3723. The examiner can normally be reached on during the work week..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2193

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Todd Ingberg', with a long horizontal line extending to the right.

Todd Ingberg  
Primary Examiner  
Art Unit 2193

TI